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Patent**REMARKS**

The above-referenced patent application has been reviewed in light of the Office Action referenced above. Reconsideration of the above-referenced patent application in view of the following remarks is respectfully requested.

Claims 1-16 are pending in the application. Claims 1, 7 and 12 have been amended. The amendment is fully supported by the original disclosure. No new matter has been introduced. The above amendments were, in many instances, made to clarify Assignee's claims and do not narrow the scope of the amended claims. Furthermore, in many instances, the above amendments broaden the literal scope of claims and/or claim elements. In light of this, Assignee asserts that no prosecution history estoppel should result from the above amendments, in many instances.

Allowable Subject Matter:

The Examiner has indicated that dependent claims 2-4, 8-11, 13-16 would be allowable if rewritten in independent format.

In view of this, Assignee has amended independent claim 7 to recite "*wherein the scanner scans at less than full speed if the count data is smaller than approximately 3/4 of the largest data access volume*", consistent with portions of allowable dependent claims 9 and 10. Accordingly, Assignee submits that independent claim 7 is patentably distinguishable from the cited references.

Claims 8-11 are similarly allowable, at least on the same or similar basis as claim 7.

Likewise, Assignee has amended independent claim 12 to recite "*wherein the scanning speed is at less than full speed if the count data is smaller than approximately 3/4 of the largest data access volume*", consistent with portions of allowable dependent claims 14 and 15. Accordingly, Assignee submits that independent claim 12 is patentably distinguishable from the cited references.

Claims 13-16 are similarly allowable, at least on the same or similar basis as claim 12.

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PatentClaim rejections – 35 USC §103(a)

Claims 1, 5, 6, 7, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakaguchi (U.S. Patent No. 6,490,057), in view of Bell (U.S. Patent No. 4,748,514).

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. MPEP 2142. To establish a prima facie case of obviousness, three basic criteria must be met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2142.

Claims 7 and 12 have been amended, as discussed above, to incorporate allowable subject matter, so will not be discussed further herein.

Assignee respectfully submits the Examiner has not established that the proposed combination discloses all of the elements of independent claim 1. For example, Examiner has not established that the proposed combination discloses ***“a decision device coupled to an input device, said decision device capable of receiving input image data and outputting decision data based at least in part on count data and data access volume; and a driving device coupled to the decision device capable of receiving the decision data and capable of adjusting the scanning speed according to the decision data”***. In the present Office Action, the Examiner asserts that Sakaguchi discloses “a decision device (scaling processor 20 of fig 3) coupled to an input device (CCD scanner 9 of fig 1), said decision device (20 of fig 3) capable of receiving the input image data and outputting decision (output image data 23 of fig 4) data based at least in part on count data and data access volume; a driving device (driving device 17 of fig 3) coupled to the decision device (processor 20 of fig 3) for receiving the decision data.” See pages 2-3 of the Office Action. However, the Examiner has not established any support from the figures or the specification indicating that item 17 coupled with item 20 of Sakaguchi to be capable of ***“receiving the decision data”*** as claimed. Specifically, Figure 3 of Sakaguchi referenced by the examiner illustrates an arrow from item 17 to item 20; however, Figure 3 of Sakaguchi **does not** show any arrow directed from item 20 to item 17, therefore, contrary to the Examiner’s

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assertion, Sakaguchi does not teach “a driving device coupled to the decision device capable of receiving the decision data” as claimed in claim 1. This is so because the arrow in Figure 3 between item 17 and item 20 of Sakaguchi points in the wrong direction. Likewise, column 8, lines 32-43 of Sakaguchi discuss the operation of item 17 and item 20 as follows:

The photoelectric conversion element 9 which is driven by the **CCD driver 17** **supplies the image signal in every one-pixel unit to the scaling processor 20.**

The scaling processor 20 outputs the output image 23 of the multi-gradation. Also the scaling processor 20 outputs the output image transfer clock 24 as the clock for transferring the image and the effective pixel signal 22 for representing whether the outputted pixel is the effective pixel. It becomes possible to carry out the next image processing (gamma correction and binarization processing) due to these signals. (emphasis added)

Assignee respectfully submits that based on Figure 3 and the above section of the specification, the Examiner has not established that there is any communication from item 20 of Sakaguchi to item 17, let alone the “receiving the decision data” as claimed. Lastly, the Examiner has not established that Bell cures Sakaguchi of this failure. In the absence of the Examiner pointing to such a disclosure in the proposed combination, Assignee requests that the rejection be withdrawn as the Examiner has failed to establish that the proposed combination renders obvious all of the features of claim 1.

Claims 5 and 6 are similarly not obvious, at least on the same or similar basis as claim 1.

It is noted that claimed subject matter may be patentably distinguished from the cited references for additional reasons; however, the foregoing is believed to be sufficient. Likewise, it is noted that the Assignee's failure to comment directly upon any of the positions asserted by the Examiner in the office action does not indicate agreement or acquiescence with those asserted positions.

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Conclusion

In light of the foregoing, reconsideration and allowance of the claims is hereby earnestly requested.

Any fees or extensions of time believed to be due in connection with this amendment are enclosed herein; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-3703.

Invitation for a Telephone Interview

The Examiner is invited to call the undersigned attorney, James J. Lynch, at (503) 439-6500 if there remains any issue with allowance.

Respectfully submitted,
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